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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,426	04/23/2002	Richard A. Baker JR.	SAA-89	4974
23569	7590	01/04/2005		
SQUARE D COMPANY INTELLECTUAL PROPERTY DEPARTMENT 1415 SOUTH ROSELLE ROAD PALATINE, IL 60067			EXAMINER YUAN, ALMARI ROMERO	
			ART UNIT 2176	PAPER NUMBER

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/063,426	<b>Applicant(s)</b> BAKER ET AL.	
	<b>Examiner</b> Almari Yuan	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This action is responsive to communications: Application filed on 4/23/02.
2. Claims 1-9 are pending in the case. Claims 1, 3, and 7 are independent claims.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 7-9 set forth non-functional descriptive material but fail to set forth physical structures or materials comprising of hardware or a combination of hardware and software within the technological arts (i.e. a computer) to produce a “useful, concrete and tangible” result. The language of “computer program for electronically placing bates stamps on one or more documents ” of claims 7-9, is interpreted as software per se and is not tangibly embodied on a computer readable medium or hardware.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-2 rejected under 35 U.S.C. 102(e) as being anticipated by Hansen (USPN 6,509,974 B1 – filed 05/2000).**

**Regarding independent claim 1**, Hansen discloses:

A method for producing documents in a legal proceeding (Hansen on col. 7, lines 46-48 teaches production of printed documents) the method comprising:

converting a set of files to a common electronic file type (Hansen on col. 4, lines 57-60 and col. 7, lines 64-66 teaches converting documents into a common file format such as PDF) in a directory tree (Hansen on col. 8, lines 1-8 teaches directory of files for conversion); and

electronically stamping each file with a bates stamp (Hansen on col. 6, lines 23-28 teaches adding bates numbering; col. 10, lines 18-19 and col. 13, line 41 teaches bates stamping pages and StampPDF) .

**Regarding dependent claim 2**, Hansen discloses:

preserving the directory tree on a CD ROM (Hansen on col. 1, lines 29-33 teaches documents stored in compact disc to be transmitted to the print shop).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 3, 5-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen (USPN 6,509,974 B1 – filed 05/2000) in view of "Digital Applications, Inc. Announces the release of StampPDF Plug-In 2.0", 01/2001, Planet PDF, web.archive.org for <<http://www.plantpdf.com/mainpage.asp?webpageid=538>>, pages 1-2 (herein after "Digital").**

**Regarding independent claim 3, Hansen discloses:**

The method of placing a bates stamp on an electronic document (Hansen on col. 6, lines 23-28 teaches adding bates numbering to documents; col. 10, lines 18-19 and col. 13, line 41 teaches bates stamping) the method comprising:

using a stamping mechanism to place a bates stamp on each page of a file (Hansen on col. 6, lines 10-29 teaches adding bates stamp to one or more pages);

preserving the next bates stamp number (Hansen on col. 2, lines 1-3 and col. 6, lines 23-28 teaches bates numbering).

However, Hansen does not explicitly teach “incrementing the bates stamp for each page of said file” and “bates stamp for use by a subsequent file”.

Digital on page 1 teaches StampPDF will now stamp every second page, or every third page (in order), or any predefined increment of pages. For example, every second page to support odd and even pages.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Digital into Hansen to provide a way to using StampPDF to stamp every page or every third page or increment of pages, as taught by Digital, incorporated

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into the stamping system of Hansen, in order to enhance the editing and manipulation of documents.

**Regarding dependent claim 5**, Hansen discloses “stamping” performed on multiple files, on col. 6, lines 23-28 teaches bates numbering on multiple documents and on col. 10, lines 18-22 teaches bates stamping).

**Regarding dependent claim 6**, Hansen discloses “multiple files are contained in a directory tree”, on col. 8, lines 1-8 teaches directory containing files.

**Regarding independent claim 7**, Hansen discloses:

A computer program for electronically placing bates stamps on one or more documents (Hansen on col. 6, lines 23-28 teaches adding bates numbering to documents; col. 10, lines 18-19 and col. 13, line 41 teaches bates stamping), comprising:

software instructions to place a bates stamp on each page of each document (Hansen on col. 6, lines 10-29 teaches adding bates stamp to one or more pages).

Hansen teaches “bates numbering” on col. 2, lines 1-3 and col. 6, lines 23-28.

However, Hansen does not explicitly teach “increment the bates stamp for each page” and “incrementing bates numbering through each successive document”.

Digital on page 1 teaches StampPDF will now stamp every second page, or every third page (in order), or any predefined increment of pages. For example, every second page to support odd and even pages.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Digital into Hansen to provide a way to using StampPDF to stamp every page or every third page or increment of pages, as taught by Digital, incorporated

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into the stamping system of Hansen, in order to enhance the editing and manipulation of documents.

**Regarding dependent claim 9**, Hansen discloses “placing the bates stamps on a directory tree of documents”, on col. 8, lines 1-8 teaches directory of files and on col. 6, lines 10-29 teaches bates stamping documents.

9. **Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen in view of Digital Applications, as applied to claims 3 and 7 above, and further in view of Robins (USPN 5,392,428 – issued 02/1995).**

**Regarding dependent claims 4 and 8**, Hansen and Digital discloses the invention substantially as claimed as described above. However, Hansen and Digital do not explicitly disclose “creating a log file for document”.

Robins teaches a Log File that allows the system to maintain a listing of all work performed on a particular portion of the source text. This may include the name of the person who entered or summarized the text, the dates and times when they worked on the source text, and the duration of time spent working on the source text, on col. 13, lines 5-25 and on col. 10, lines 25-30 Table 11 teaches Bates numbering.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Robins into Hansen and Digital to provide a Log file of a source text, as taught by Robins, incorporated into the systems of Hansen and Digital, in order to allow the flexibility to keep track of information related to the source text.

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***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bernstein, Paul, "Perform litigation tricks with Adobe Acrobat", 02/2001, Trial. Washington, Vol. 37, Issue 2, pages 1-3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is 571-272-4104. The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AY  
December 22, 2004

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER